



UNITED STATES PATENT AND TRADEMARK OFFICE

107
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,942	02/14/2002	Matthew D. Putnam	09531-075001	1734

26191 7590 04/25/2005

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

REIP, DAVID OWEN

ART UNIT	PAPER NUMBER
----------	--------------

3731

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,942

Applicant(s)

PUTNAM ET AL.

Examiner

David O. Reip

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 9-25, 28, 29, 31, 32, 35, 36 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 26, 27, 30, 33, 34, 37, 38 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/14/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of the species of invention which includes the combination of plate species 6 (as shown in Figs. 68-70), tensioning device species 1 (as shown in Fig. 31), and articulating tine species 1 (as shown in Fig. 48), in the reply filed on 2/10/05 is acknowledged.

Claims 15-25, 31, 32, 35, and 39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/10/05. Further, claims 9-14, 28, 29, and 36 are seen by the examiner as reciting limitations that are not consistent with the elected species of invention, and are additionally withdrawn. Support for the additional claims withdrawal is as follows:

With respect to the elected plate species 6 (Figs. 68-70), a review of the applicant's disclosure relevant to this elected species reveals that the sum total of specific details are found in the last paragraph of page 18 and finishing on page 19. Nowhere in this brief section of disclosure are found any of the limitations as to range of angles between the distal and proximal portions of the plate and tine extension angles as recited in claims 9-14. With respect to claim 28, the recited outwardly extending rounded surfaces of the first opening are not consistent with elected plate species 6, and the head having a concave articulating portion is not consistent with elected articulating tine species 1. With respect to claims 29 and 36, the articulating portion having an elongated shape is not consistent with elected articulating tine species 1.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claim 1 is objected to because of the following informalities: in line 1, "facture" is an apparent misspelling of --fracture--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 26, 27, 33, 34, 38, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Esser (U.S. Pat. No. 6,096,040). Figs. 16-18 and 23 of Esser show a fixation plate kit for fixation of a distal radius fracture having all the limitations as

Art Unit: 3731

recited in the above listed claims, including: a generally T-shaped, angled plate 140 having a distal portion 144 and a proximal portion 142; at least one "tine" (a bone screw in the upper right corner of the distal portion of the plate, see Fig. 23) extending from the distal portion of the plate; openings 172 in the distal portion of the plate; openings 158 and 160 in the proximal portion of the plate; and at least one "tensioning device" (any one of the bone screws in the holes in the proximal portion of the plate, see Fig. 23). With respect to the limitation of the tine being configured as an "articulating member," it is seen that the "tine" (a bone screw, as discussed above), when placed through any of the distal portion holes 172, would have the inherent capability to articulate at least a few degrees in every direction.

Claims 1-4, 6-8, 26, 27, 30, 33, 34, 37, 38, and 40 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Orbay et al (U.S. Pat. No. 6,440,135). Figs. 25-28 and the associated disclosure in col. 7 of Orbay et al clearly show a volar fixation system having all the limitations as recited in the above listed claims, to include tines 308 that are specifically configured for articulation.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 3731

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No.

6,755,831. Although the conflicting claims are not identical, they are not patentably distinct from each other because application claims 1-3 and 5 recite substantially the same limitations as those recited and covered by claims 1-2 of the '831 patent. It is noted that the application claims are somewhat broader in scope than the patent claims, and are therefore seen as being "generic" to the narrower "species" claims of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Accordingly, absent a terminal disclaimer, claims 1-3 and 5 are properly rejected under the doctrine of obviousness-type double patenting. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David O. Reip whose telephone number is 571-272-4702. The examiner can normally be reached on 7 A.M.- 4 P.M. Mon-Thu and every other Fri..

Art Unit: 3731

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David O. Reip
Primary Examiner
AU 3731